

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants | : Yoshihiro IDA et al. | Group Art Unit: | 2622 |
| Appl. No. | : 09/334,617 | Examiner: | Heather Gibbs |
| Filed | : June 17, 1999 | Confirmation No.: | 5530 |
| For | : SERVER APPARATUS AND INTERNET FACSIMILE APPARATUSES AND COMMUNICATION TERMINAL CAPABILITY EXCHANGING METHOD | | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Official Action of November 24, 2006, in which a three-month shortened statutory period for response was set to expire on February 26, 2007 (February 24, 2007 being a Saturday), and for which a Notice of Appeal is being filed concurrently herewith, Applicants respectfully request a Pre-Appeal Brief Panel to review and withdraw the outstanding rejections set forth in the above-mentioned Official Action, in view of the herein-contained remarks:

Remarks begin on page 2 of this paper.

REMARKS

In the outstanding Official Action, claims 24-26, 30 and 34-42 were rejected under 35 U.S.C. § 102(e) as being anticipated by FEDER (U.S. Patent No. 5,872,845). Claims 28, 31 and 32 were indicated to be allowable.

In setting forth the rejection, the Examiner relied on and cited to column 10, lines 19-25 and 34-45 of FEDER. However, neither these portions of FEDER, nor any other portions of FEDER support the Examiner's position that FEDER anticipates or even renders unpatentable the claimed combinations of features recited in Applicants' pending claims.

Applicants' claim 24 recites, *inter alia*, a server connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile apparatus via the Internet. The server includes a memory configured to store reception capabilities regarding a type of facsimile data that the receiving Internet apparatus can receive, the receiving Internet apparatus being distinct from the server apparatus and the reception capabilities being distinct from the facsimile data.

However, the FEDER structure is different than the claim recitations.. At column 10, lines 19-25, FEDER discloses re-encoding, by the remote server 550, of the data into several formats such as MH, MR or MMR. The server then stores them in memory as data files created for each such format.

Further, FEDER utilizes a DIS signal, that is transmitted by the destination fax machine 570 to the remote server 550. The remote server, based upon the DIS signal,

transmits the data in an appropriate format to the destination fax machine and erases data stored in the other formats from the memory (column 10, lines 28-31).

This operation of the FEDER device noted by the Examiner is totally illogical, if FEDER operates according to the recitations of the claims of the present application. In other words, if FEDER stores reception capabilities in the memory, there is no need to encode the data message into several formats and later discard (i.e., erase) the unnecessary formats (i.e., the format is inconsistent with the capabilities of the destination fax machine) since, according to the claim recitations, the reception capabilities are stored in memory. Accordingly, the first paragraph relied upon by the Examiner provides absolutely no support for the Examiner's position that FEDER stores reception capabilities in a memory of the server. On the contrary, this portion supports the patentability of the pending claims.

The second paragraph cited by the Examiner also does not support his position. In this regard, Applicants note that the present invention is directed to a server. In direct contrast, column 10, line 34, of FEDER refers to a "service" that maintains a registry of fax machines. This is clearly not what is recited by Applicants' claim and this defect alone supports the allowability of the claims.

Moreover, even if one assumes, without any supporting evidence, that this part of FEDER requires a memory of a server, FEDER discloses at lines 42-43 that the capability of the intended recipient is determined "on the basis of the data stored therein". In other words, it is the "data" that is the basis for the determination of the capability of the

recipient. The term “data” in line 40 appears to refer to the “data files” mentioned at line 28. However, Applicants’ claims explicitly recite that the “reception capabilities” are distinct from the “facsimile data”. Accordingly, this portion of FEDER also does not support the Examiner’s interpretation and application thereof against the claims of the present application.

Yet further, even if the above two deficiencies are overlooked, FEDER still cannot anticipate the pending claims. In this regard, Applicants’ claims recite that the “reception capabilities” are stored. Even if one were to assume that FEDER is still applicable to the claims of the present application, FEDER merely discloses storing the “capability to determine” rather than storing the “reception capabilities”. There is a significant difference between being able to determine capabilities based upon data, and storing the reception capabilities in the memory.

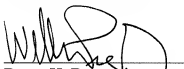
Accordingly, each of the portions of FEDER upon which the Examiner relies do not in any manner support his application of FEDER against the claims of the present application, for each and certainly for all of the above-noted reasons. Thus, FEDER cannot anticipate any of claims in the present application.

CONCLUSION

Accordingly, it is submitted that the rejection of any of the claims in the present application as anticipated by FEDER is inappropriate. Thus, Applicants respectfully request review of the outstanding rejection and an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Should the Examiner have any questions regarding the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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February 26, 2007
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